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7590 Hunton & Williams 1900 K Street, N.W. Washington, DC 20006-1109			EXAMINER BOSWELL, BETH V	
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1 UNITED STATES PATENT AND TRADEMARK OFFICE  
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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* CHRISTOPHER W. BLENK  
9

10  
11 Appeal 2008-0409  
12 Application 09/678,313  
13 Technology Center 3600  
14

15  
16 Decided: August 12, 2008  
17

18  
19 Before HUBERT C. LORIN, ANTON W. FETTING, and  
20 STEVEN D.A. MCCARTHY, *Administrative Patent Judges*.

21  
22 FETTING, *Administrative Patent Judge*.  
23

24  
25 DECISION ON APPEAL

26 STATEMENT OF THE CASE

27 Christopher W. Blenk (Appellant) seeks review under 35 U.S.C. § 134  
28 of a final rejection of claims 1-36, the only claims pending in the application  
29 on appeal.

30 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)  
31 (2002).

1 We AFFIRM.

2  
3 The Appellant invented a way in which partial works are submitted  
4 for review by readers, reader feedback is captured and focused more on  
5 submitted partial works having a high potential for success, and the results  
6 are quantified for use by authors, writers, agents, publishers, and the readers  
7 themselves (Specification 4:7-16).

8 An understanding of the invention can be derived from a reading of  
9 exemplary claim 1, which is reproduced below [bracketed matter and some  
10 paragraphing added].

- 11 1. A system for providing reader-supplied evaluation of a  
12 sample of an authored work for potential publication of the  
13 work comprising:  
14 [1] an author interface module,  
15 operably connected to the Internet,  
16 for receiving only a portion of a work from an author  
17 to be reviewed via the Internet;  
18 [2] storage means  
19 for storing the portion of the work  
20 along with other portions of works for review;  
21 [3] a reader interface module  
22 for receiving a request from a reader  
23 to review the portion of a work stored in the storage  
24 means;  
25 [4] work presentation means  
26 for presenting the portion of a work  
27 to the reader  
28 based on the reader's request;  
29 [5] security means  
30 for implementing at least one security mechanism  
31 to limit the ability of users  
32 to misappropriate credit  
33 for the portion of work

- 1 if the work were to be resubmitted to the storage  
2 means by another author  
3 including a timestamp  
4 associated with a time of first receipt  
5 of the portion of work from the author  
6 that may be used by the system in resolving  
7 disputes regarding original authorship;  
8 [6] a review receiving module  
9 for receiving evaluation  
10 of the portion of the work  
11 from the reader and  
12 placing the review in the storage means associated with  
13 the portion of the work; and  
14 [7] criteria determination means  
15 for determining whether the portion of the work meets  
16 predetermined reader-satisfaction criteria.  
17

18 This appeal arises from the Examiner's final Rejection, mailed January  
19 27, 2006. The Appellant filed an Appeal Brief in support of the appeal on  
20 December 14, 2006. An Examiner's Answer to the Appeal Brief was mailed  
21 on April 10, 2007. A Reply Brief was filed on June 1, 2007. Oral  
22 arguments were presented at a hearing on July 10, 2008.  
23

#### 24 PRIOR ART

25 The Examiner relies upon the following prior art:

26 Kurzrok	US 6,260,064 B1	Jul. 10, 2001
27 Phillips	US 6,473,084 B1	Oct. 29, 2002
28 Teppler	US 6,948,069 B1	Sep. 20, 2005

REJECTIONS

Claims 1-5, 8-12, 15-19, 22-26, 35, and 36 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Kurzkro and Teppler.

Claims 6, 7, 13, 14, 20, 21, and 27-34 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Kurzkro, Teppler, and Phillips.

ISSUES

The issues pertinent to this appeal are

- Whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 1-5, 8-12, 15-19, 22-26, 35, and 36 under 35 U.S.C. § 103(a) as unpatentable over Kurzkro and Teppler.
- Whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 6, 7, 13, 14, 20, 21, and 27-34 under 35 U.S.C. § 103(a) as unpatentable over Kurzkro, Teppler, and Phillips.

The pertinent issue turns on whether submitting a portion of a work patentably distinguished over submitting the entire portion of a work, and whether the references were properly combined.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

*Kurzkro*

01. Kurzkro is directed to an electronic publishing system to display at least one article or advertisement. The system includes receiving ratings from a reader evaluating an article or

advertisement; receiving and storing information including ratings related to a site including at least one article and a plurality of advertisements; and totaling ratings from a plurality of readers to generate rating indicia. The indicia may include a combined article rating parameter for the article or a combined advertisement rating for said advertisement based on ratings from a plurality of readers (Kurzrok 1:50-65).

02. Kurzrok describes authors adding content through input (Kurzrok 2:36-41); storage for the content (Kurzrok 2:33-36); receiving a request from a reader to review content and presenting the content (Kurzrok 3:33-38); receiving evaluations into storage (Kurzrok 3:59-64); and determining levels of reader satisfaction (Kurzrok 3:9-19).

03. Kurzrok describes the reader as providing rating information about the contents of an article as being one of "excellent (E)," "good (G)," "fair (F)," or "no value (NV)" (Kurzrok 3:13-17).

04. Kurzrock describes the reader as providing such demographic information as whether the reader is a consumer or travel professional and this data is used in computing satisfaction statistics (Kurzrock 3:22-24; Figs. 4A-C).

05. Kurzrock describes how, after a rating is received, when a request for a rating summary is received or at regular intervals, cumulative rating parameters are calculated for each article and advertisement (Kurzrock 3:65-67).

06. Kurzrock describes computing the percentage of readers who vote for each rating category (Kurzrock 4:18-20).

07. Kurzrock describes computing a ratings summary by calculating the number of entries in each rating sub-category (excellent, fair, good, or no value) for each article or ad. The percentage of the total is then calculated, then each percentage is run through a set of rules that determine the rating (Kurzrock 4:34-38).

*Phillips*

08. Phillips is directed to forecasting contests that include features directed to ranking of the participants and that result in a database of prediction data. It is further directed to conducting a contest that produces forecasting data for predesignated variables whose values change over time. By ranking individuals based on their relative accuracies in individual prediction events, a contest permits an overall ranking within a group of participants even though the participants in the group might be predicting different combinations of variables or might be predicting for different time horizons (Phillips 6:65 – 7:15).

09. Phillips describes removing lowest ranked documents from what is available to be read (Phillips 37:19-23).

*Teppler*

10. Teppler is directed to fraud prevention in digital files (Teppler 14:1-4) by proving dates of digital-imaging files, generally by use of a trusted time source; saving a file at a moment in time; using an application program interface (API) for selectively retrieving from the trusted time source a date and a time corresponding to the moment in time; and appending the date and the time retrieved

1 from the trusted time source to the saved file. This includes  
2 signing the saved file with the date and the time retrieved from the  
3 trusted time source, hashing the signed file to produce a digest,  
4 signing the digest with a key to produce a certificate, appending  
5 the certificate to the saved file, and saving the file with the  
6 certificate appended thereto. Means for performing all of the  
7 foregoing are sealed together within a tamperproof environment  
8 (Teppler 14:49-64).

9 *Facts Related To The Level Of Skill In The Art*

10 11. Neither the Examiner nor the Appellant has addressed the level  
11 of ordinary skill in the pertinent arts of copyright law, publishing,  
12 literary critique, systems analysis and programming, network  
13 security, intellectual property security, and authoring. We will  
14 therefore consider the cited prior art as representative of the level  
15 of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d  
16 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings  
17 on the level of skill in the art does not give rise to reversible error  
18 ‘where the prior art itself reflects an appropriate level and a need  
19 for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v.*  
20 *Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

21 *Facts Related To Secondary Considerations*

22 12. There is no evidence on record of secondary considerations of  
23 non-obviousness for our consideration.  
24



PRINCIPLES OF LAW

*Claim Construction*

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

*Obviousness*

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been

1 obvious at the time the invention was made to a person having ordinary skill  
2 in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S. Ct.  
3 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14  
4 (1966).

5 In *Graham*, the Court held that the obviousness analysis is bottomed  
6 on several basic factual inquiries: “[1] the scope and content of the prior art  
7 are to be determined; [2] differences between the prior art and the claims at  
8 issue are to be ascertained; and [3] the level of ordinary skill in the  
9 pertinent art resolved.” 383 U.S. at 17. See also *KSR Int’l v. Teleflex Inc.*,  
10 127 S. Ct. at 1734. “The combination of familiar elements according to  
11 known methods is likely to be obvious when it does no more than yield  
12 predictable results.” *KSR*, at 1739.

13 “When a work is available in one field of endeavor, design incentives  
14 and other market forces can prompt variations of it, either in the same field  
15 or a different one. If a person of ordinary skill can implement a predictable  
16 variation, § 103 likely bars its patentability.” *Id.* at 1740.

17 “For the same reason, if a technique has been used to improve one  
18 device, and a person of ordinary skill in the art would recognize that it would  
19 improve similar devices in the same way, using the technique is obvious  
20 unless its actual application is beyond his or her skill.” *Id.*

21 “Under the correct analysis, any need or problem known in the field  
22 of endeavor at the time of invention and addressed by the patent can provide  
23 a reason for combining the elements in the manner claimed.” *Id.* at 1742.

1    *Automation of a Known Process*

2            It is generally obvious to automate a known manual procedure or  
3    mechanical device. Our reviewing court stated in *Leapfrog Enterprises Inc.*  
4    *v. Fisher-Price Inc.*, 485 F.3d 1157 (Fed. Cir. 2007) that one of ordinary  
5    skill in the art would have found it obvious to combine an old  
6    electromechanical device with electronic circuitry

7            to update it using modern electronic components in  
8            order to gain the commonly understood benefits of  
9            such adaptation, such as decreased size, increased  
10          reliability, simplified operation, and reduced cost  
11          . . . . The combination is thus the adaptation of an  
12          old idea or invention . . . using newer technology  
13          that is commonly available and understood in the  
14          art.

15    *Id.* at 1162.

16    *Obviousness and Nonfunctional Descriptive Material*

17          Nonfunctional descriptive material cannot render nonobvious an  
18    invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d  
19    1336, 1339 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed.  
20    Cir. 1983) (when descriptive material is not functionally related to the  
21    substrate, the descriptive material will not distinguish the invention from the  
22    prior art in terms of patentability).

ANALYSIS

*Claims 1-5, 8-12, 15-19, 22-26, 35, and 36 rejected under 35 U.S.C.  
§ 103(a) as unpatentable over Kurzrok and Teppler.*

*Claims 1 and 15*

The Appellant argues these claims as a group.

Accordingly, we select claim 1 as representative of the group.  
37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Kurzrok described all the limitations in claim 1 except for limitation [6], a security means including a timestamp. The Examiner found that Teppler described using a timestamp as a security means for electronic documents to show origination. The Examiner concluded that it would have been obvious to a person of ordinary skill in the art to have applied Teppler's timestamp to Kurzrok's web site rating system for Teppler's purpose of showing origination (Answer 3-5).

The Appellant contends that Kurzrok fails to describe limitations [7] (Appeal Br. 5:First ¶ following A.), or [5] (Appeal Br. 6:Top ¶), and that there was no reason to apply Teppler to Kurzrok or to use Teppler to show time of submission rather than time of creation (Appeal Br. 7: First full ¶). The Examiner responded that Kurzrok provides the predetermined measures reader satisfaction of limitation [7] as excellent, good, fair, or no-value and percentages of satisfaction (Answer 12); that Teppler rather than Kurzrok was relied upon for the time stamp security of limitation [5] (Answer 13) and that the application of Teppler was based on the knowledge of one of ordinary skill (Answer 14). The Appellant repeated its contentions in the Reply Brief and added an argument that Kurzrok did not describe submitting only a portion of the work (Reply Br. 6:¶ B).

1           We disagree with the Appellant. Initially we find that none of the  
2     remaining limitations are under contention and that Kurzrok describes those  
3     limitations (FF 01 - 02).

4           We find that Kurzrok rates author submissions into predefined  
5     categories of excellent, good, fair, and no value (FF 03). We further find  
6     that limitation [7] of claim 1, which requires predetermined reader-  
7     satisfaction criteria, does not limit the nature of such criteria. Such criteria  
8     may be qualitative rather than quantitative and may be subjective rather than  
9     objective and still meet the claim limitation, so long as the criteria are  
10    predefined. Since Kurzrok predefines subjective levels of reader  
11    satisfaction, Kurzrok clearly describes determining whether the work meets  
12    predetermined reader-satisfaction criteria by having the reader enter the  
13    criteria measure the reader chooses.

14          We also find that the Examiner is correct that Teppler was applied for  
15    the timestamp, so the Appellant's argument that Kurzrok fails to describe the  
16    timestamp is simply attacking references separately. Nonobviousness  
17    cannot be established by attacking the references individually when the  
18    rejection is predicated upon a combination of prior art disclosures. *See In re*  
19    *Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). As to whether one of  
20    ordinary skill would have applied Teppler to Kurzrok, we agree with the  
21    Examiner that Teppler's reason of fraud prevention (FF 10) would apply to  
22    any digital work of authorship, including that in Kurzrok.

23          As to the argument introduced in the Reply Brief that Kurzrok does  
24    not describe submitting only a portion of a work, we find first that this does  
25    not preclude submitting an entire work, since an entire portion is  
26    nevertheless a portion, and that there is no structure recited in the claim for

1 limiting the amount of the work that is submitted. The Appellants admitted  
2 this at oral hearing (Hearing Transcript 6:21 – 7:3). Therefore this is not a  
3 structural limitation within apparatus claim 1. "[E]xpressions relating the  
4 apparatus to contents thereof during an intended operation are of no  
5 significance in determining patentability of the apparatus claim." *Ex parte*  
6 *Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of  
7 material or article worked upon by a structure being claimed does not impart  
8 patentability to the claims." *In re Young*, 75 F.2d 996, 998 (CCPA 1935) (as  
9 restated in *In re Otto*, 312 F.2d 937, 940 (CCPA 1963)).

10 *Claims 3, 9, 17, and 23*

11 The Appellant argues these claims as a group. Accordingly, we select  
12 claim 3 as representative of the group. Claim 3 requires that the analysis  
13 indicate the percentage of readers that would purchase the work. The  
14 Examiner found that Kurzrok described computing the percentage that rate a  
15 work as good or excellent and concludes that such a rating suggests a  
16 willingness to buy (Answer 6-7). The Appellant contends that there is not  
17 necessarily a correlation (Appeal Br. 7: ¶ B).

18 We disagree with the Appellant. Claim 3 does not require an accurate  
19 prediction of the number who would purchase, or even a record of actual  
20 purchases. Claim 3 therefore simply requires a number expressed as a  
21 percentage that is indicative of how many customers might purchase a work.  
22 Kurzrok describes computing a percentage of readers who vote for each  
23 rating category (FF 05). The ratings favorable to the works are indicative of  
24 desire to purchase, particularly since no price is claimed and a price might  
25 be *de minimis*. The percentage of favorable ratings is therefore at least

suggestive of the percentage who would purchase, and would be a  
predictable statistic to use for such an estimate to one of ordinary skill.

*Claims 4 and 18*

The Appellant argues these claims as a group. Accordingly, we select  
claim 4 as representative of the group. Claim 4 requires determining  
whether a predetermined number of reviews have been made prior to  
evaluating whether the reader-satisfaction criteria have been met. The  
Examiner found that the number of reviews was counted prior to computing  
final satisfaction statistics and therefore the number of reviews was  
predetermined at the time of the computation (Answer 16: First full ¶). The  
Appellant repeats the contentions regarding reader satisfaction criteria from  
claim 1, which we find unpersuasive for the same reasons *supra*, and also  
argues the lack of a predetermined number (Appeal Br. 8:¶ C).

We disagree with the Appellant. As the Examiner found, Kurzrok  
computes the number of entries in each rating sub-category (excellent, fair,  
good, or no value) for each article or ad. The percentage of the total is then  
calculated, then each percentage is run through a set of rules that determine  
the rating (FF 07). Thus, the number of entries in each rating sub-category  
is predetermined at the time the percentages of total are calculated.

*Claims 5, 8, 19 and 22*

The Appellant argues these claims as a group. Accordingly, we select  
claim 5 as representative of the group. Claim 5 requires utilizing multiple  
rounds of criteria and determines whether a predetermined number of  
reviews has been made for each round prior to evaluating whether the  
reader-satisfaction criteria have been met. The Examiner found that Kurzrok

described this (Answer 16). The Appellant contends that Kurzrok does not describe multiple rounds or different criteria (Appeal Br. 8:¶ D).

We disagree with the Appellant. As the Examiner found, Kurzrok describes computing the ratings summary at regular intervals (FF 05). Such regular computations constitute multiple rounds of computations.

The Appellant appears to have made a somewhat different argument as to claim 8 within this group of claims. Claim 8 requires using different criteria. As also found by the Examiner, the claim limitation in claim 8 of different criteria for each round are not defined within the claim. Thus, we find that since Kurzrok relies on subjective evaluations, Kurzrok's different readers will apply different criteria.

*Claims 10, 11, 24 and 25*

The Appellant argues these claims as a group. Accordingly, we select claim 10 as representative of the group. Claim 10 requires that predetermined number of reviews is based on demographics of the readers so that the criteria determination means evaluates the reader-satisfaction criteria after certain numbers of readers from each of a plurality of demographics has evaluated the work. The Examiner found that Kurzrok described this (Answer 7).

The Appellant admits that Kurzrok uses demographics, but repeats the contention from claim 4 that a predetermined number is not used and from this infers that the claim limitation is not met (Appeal Br. 8:¶ E). We find that Kurzrok does use demographic data and that this information is used in computing reader satisfaction statistics (FF 04). Since, as we found *supra* the number of such evaluations are known prior to computing percentage statistics, the number of reviews is predetermined at the time such



percentages are computed. Such numbers, once known are also “certain numbers” as required by claim 10.

*Claim 35*

Claim 35 requires providing only a portion of the work to limit access of the reader to the entirety of the work. The Examiner found that Kurzrock describes this limitation (Answer 8). The Appellant contends that Kurzrock does not describe only a portion (Appeal Br. 9:¶ F). We find this is a repetition of the Appellant’s argument regarding a portion in claim 1 and we find the argument unpersuasive for the same reasons we found *supra*.

The Appellant has not sustained its burden of showing that the Examiner erred in rejecting claims 1-5, 8-12, 15-19, 22-26, 35, and 36 under 35 U.S.C. § 103(a) as unpatentable over Kurzrock and Teppler.

*Claims 6, 7, 13, 14, 20, 21, and 27-34 rejected under 35 U.S.C. § 103(a) as unpatentable over Kurzrock, Teppler, and Phillips.*

The Appellant argued that these claims are patentable for the same reasons their parent claims are patentable and that the Examiner failed to show that one of ordinary skill would have further applied Phillips (Appeal Br. 9: ¶ G). The Examiner responded that Phillips describes removing work that does not meet certain reader satisfaction criteria, and that one of ordinary skill would have known to apply this to Kurzrock’s web documents whose evaluations receive payment, since minimizing cash outflow is a well known motivation (Answer 16-17; FF 09).

We agree with the Examiner that Phillips’ removal of the lowest rating documents would have motivated one of ordinary skill to apply Phillips to Kurzrock to minimize payments for ratings. Common sense

suggests avoiding paying for that which is unnecessary. “Rigid preventative rules that deny factfinders recourse to common sense ... are neither necessary under our case law nor consistent with it.” *KSR*, 127 S. Ct. at 1742-43.

The Appellant has not sustained its burden of showing that the Examiner erred in rejecting claims 6, 7, 13, 14, 20, 21, and 27-34 under 35 U.S.C. § 103(a) as unpatentable over Kurzrok, Teppler, and Phillips.

#### CONCLUSIONS OF LAW

The Appellant has not sustained its burden of showing that the Examiner erred in rejecting claims 1-36 under 35 U.S.C. § 103(a) as unpatentable over the prior art.

#### DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-5, 8-12, 15-19, 22-26, 35, and 36 under 35 U.S.C. § 103(a) as unpatentable over Kurzrok and Teppler is sustained.
- The rejection of claims 6, 7, 13, 14, 20, 21, and 27-34 under 35 U.S.C. § 103(a) as unpatentable over Kurzrok, Teppler, and Phillips is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

**AFFIRMED**

1   hh  
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5